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PTO/SB/33 (07-05)

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Docket Number (Optional)

NOKM.075PA

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on 02/15/2007Signature Typed or printed name Rennae Johnson

Application Number

10/717,992

Filed

11/20/2003

First Named Inventor

Marko Torvinen

Art Unit

2617

Examiner

Le, D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

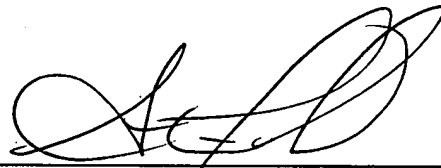
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 37,830
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Steven R. Funk

Typed or printed name

952-854-2700

Telephone number

2/15/2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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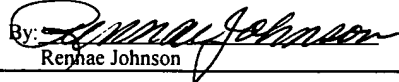
SERIAL NO.10/717,992

PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	TORVINEN et al.	Examiner:	Le, D.
Serial No.:	10/717,992	Group Art Unit:	2617
Filed:	November 20, 2003	Docket No.:	NOKM.075PA
Title:	METHOD AND SYSTEM FOR LOCATION BASED GROUP FORMATION		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 15, 2007.

By: 
Renhae Johnson

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005 on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

The Appellant notes the objections and conditional allowance of Claims 4 and 5, and thanks the Examiner for favorable consideration of these claims.

Claims 1-10, 14, and 16-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0096628 to Bar-On *et al.* (hereinafter "*Bar-On*"). Claims 11-13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bar-On* in view of U.S. Publication No. 2005/0221812 to Gailey *et al.* (hereinafter "*Gailey*").

While the Appellants have multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements needed for a *prima*

facie rejection. Each rejection in the final Office Action (dated 8-16-2006) involves the *Bar-On* reference, and relies on the *Bar-On* reference as teaching all or a substantial portion of each of the rejected claims, whether rejected under 35 U.S.C. §102(e) on *Bar-On* alone or under 35 U.S.C. §103 where *Bar-On* is the primary reference.

The issue for purposes of this request for review relates defining criteria using a mobile terminal, where that criteria is used to determine minimum *capabilities required of group attendees*. To establish a *prima facie* rejection, these limitations must be present in *Bar-On*, and the Appellant respectfully submits that at least these limitations of Appellant's pending claims are not identified in *Bar-On*. Particularly, *Bar-On* does not teach at least the use of the capability criterion as recited in Appellant's independent claims 1, 10, 14, 16, 19, and 21. The cited paragraph [0066] of *Bar-On* includes some type of criterion, but not that of the pending claims. Particularly, *Bar-On*'s cited paragraph [0066] involves criterion for selecting a service area. It does not describe defining criteria that is used to determine minimum capabilities required of group attendees. It is respectfully submitted that Paragraph [0066] does not involve any criteria relating to what is required of group attendees. There is no teaching or suggestion in *Bar-On* that a terminal capability criterion is used in the formation of a group of mobile terminals as is recited in Applicants independent claims 1, 10, 14, 16, 19, and 21.

In the "Response to Arguments" in the final Office Action, the Examiner has noted that the Appellant has argued that *Bar-On* fails to teach these claimed aspects. In response, the Examiner identifies *Bar-On*'s paragraph [0074]. It is respectfully submitted that this cited paragraph provides no further evidence of correlation to the claim language. Any "criteria" referred to in paragraph [0074] of *Bar-On* relates to the selection of service areas to be included in the group call, but is silent as to using minimum capabilities required of group attendees.

It is respectfully submitted that there is an omission of an essential element needed for a *prima facie* rejection. *Bar-On* does not involve or describe defining, or using, criteria relating to the minimum capabilities required of group attendees. *Bar-On* is relied upon in both the §102(e) and §103 rejections as teaching these claimed features. Because *Bar-On* does not involve or otherwise address defining or using criteria relating to the minimum capabilities required of group attendees, the Appellant believes these claim limitations are being improperly overlooked,

and consequently there is an omission of an essential element(s) needed for a *prima facie* rejection.

It is the position of the Appellant that *Bar-On* cannot anticipate Claims 1-10, 14 and 16-21 because it does not involve or otherwise address this claimed recitation. It is also the position of the Appellant that the Examiner's reliance on *Bar-On* in the §103 rejections as teaching the defining or use of minimum capabilities required of group attendees is also inappropriate, as neither cited reference (*Bar-On*; *Gailey*) addresses this claimed feature.

As noted in the USPTO OG Notice of 12 July 2005, it is encouraged that Appellants refer to arguments already of record rather than repeating them in the request. Thus, the Appellant also refers to the Office Action response dated June 5, 2006, which was filed in response to the Office Action dated January 3, 2006. The Appellants direct the Panel's attention to pages 9-10 of the June 5, 2006 Office Action response.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that at least this rejection is improper proper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

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Respectfully submitted,

By: 

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